

REMARKS

I. Introduction

Claims 1 to 17, 19 to 23, 25 to 74, and 77 to 98 are pending in the present application. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration of the pending claims is respectfully requested.

II. Objection to the Specification

The Examiner objected to the application “since there is no summary in the present application.” Office Action at page 2. Applicants believe that the Examiner meant “Abstract” through the use of “summary” because the present application already has a “SUMMARY OF THE INVENTION” section and is missing only an Abstract. Therefore, Applicants have included herewith an Abstract obviating this objection.

III. Rejection of Claims 1-3, 5-8, 10-15, 17-27, 29-33, 35-38, 40-45, 47-51, 56-61, 70-72, 74, 77-85, 87-90, and 92 under 35 U.S.C. § 103(a)

Claims 1-3, 5-8, 10-15, 17-27, 29-33, 35-38, 40-45, 47-51, 56-61, 70-72, 74, 77-85, 87-90, and 92 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of U.S. Patent No. 6,295,061 to Park et al. (“Park et al.”), U.S. Patent No. 6,023,275 to Horvitz et al. (“Horvitz et al.”), and U.S. Patent No. 6,340,977 to Lui et al. (“Lui et al.”). Applicants respectfully submit that this rejection should be withdrawn for at least the following reasons.

In order to establish obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). The Examiner states in the Office Action at pages 2 to 3 that “Park discloses a method for overlaying an object in a window of a software application as the technique of a Pop up window overlay on main part of the screen (see Fig. 3).” Applicants respectfully submit that the use of a separate pop-up window in FIG. 3 is not the same as the use of an overlay plane in the window of a software application as recited in the present application.

Claims 1, 17, 20, 23, 31, and 47 recite “a method for overlaying an object *in a window of a software application*” (emphasis added). Claim 77 recites “a system for overlaying an object *in a window of a software application*” (emphasis added). Claims 83 and 84 recite “a medium storing a set of instructions ... to implement a method for overlaying an object *in a window of a software application*” (emphasis added). Claim 85 recites “a method for initiating the overlaying of an object *in a window of a software application*” (emphasis added). These independent claims recite that the overlaying of the object occurs in the window of the software application. A pop-up window, on the contrary, is a separate window that is placed on, but not in, a previously existing window.

Applicants further disclose in the Specification at page 3, lines 13-18:

Conventional means have not overcome the limitations of this restricted display and the only way to present a greater amount of information is to provide scrolling within an application window (the window may be the screen display) or by displaying a new window of information. The present invention solves this need by providing an alternative method of reusing the display space *without calling new windows* or leaving the data already being displayed on the screen.

(Emphasis added). Because Applicants, through the specification, regard the use of new windows, of which pop-up windows are an example, to be outside the scope of the present invention, the Examiner may not interpret “in a window of a software application” to cover pop-up windows. Instead, the object recited in the claims uses the display space of an already existing window. Applicants further disclose in the Specification on page 4, lines 2-13:

The present invention provides a method and system for using a hyperlink (also known as a hypertext link), banner advertisement (“banner”), or graphical icon *to initiate the overlaying of content* (e.g., a transparent advertisement or a technical illustration) *with a window* ... According to one example embodiment of the present invention, *the additional content is displayed in an “overlay plane”* that may be *implemented using an intrinsic layering feature* (e.g., DHTML layering) of the window’s host program, the window-based application software. ... In an alternative embodiment of the present invention, *the overlay plane may be directly*

overlaid with the underlying window without using an intrinsic layering feature of the window-based application.

(Emphasis added). Applicants disclose that the present invention allows the overlaying of content with the window either directly (e.g., through direct compositing as discussed in the Specification on page 6, lines 15-29) or by using an intrinsic layering feature of the window-based application software—not by using additional windows such as a pop-up window.

The Examiner further contends in the Office Action on page 3 that Horvitz et al. “disclose the limitation of creating, by the plug in control, a plane including the object **as the technique of the control buttons 34** for controlling the positions of the display windows on the various planes of the display system (see col. 12, lines 11-13)” (emphasis added). The cited passage (col. 12, lines 11-13) of Horvitz et al. states: “With continuing reference to FIG. 3, the control buttons 34 for controlling the positions of the display windows on the various planes of the display system are shown.” Applicants respectfully submit that the planes disclosed by Horvitz et al. refer to the display of windows and not the overlay plane of the present application. Horvitz et al. disclose on col. 3, lines 21-43:

The isometric display system performs geometric transformation operations on rectangular windows to convey the impression to the user that the windows are positioned in three-dimensional space. The impression of depth and of working in a three-dimensional space are created by transforming two-dimensional windows to appear as if the two-dimensional windows are embedded at orientations and positions in a three-dimensional isometric space. The isometric display system responds to user activation of control buttons by transforming the shape and orientation of windows consistent with the defined three-dimensional space.

More particularly described, ***the present invention provides a method of utilizing left, right, front, back, upper, and lower planes. These planes define a polyhedron*** and these planes may be referred to as “boundary planes”. ***The polyhedron surrounds a three-dimensional space used by the isometric display system to manage the configuration and position of windows containing data from applications.*** The boundary planes of the virtual space are preferably organized into a rectangular prism defining left, right, front, and back walls, a ceiling, and a floor of a four-sided room as seen when viewing the room from the outside through a selected wall or user viewpoint.

(Emphasis Added). The planes disclosed by Horvitz et al. are sides of a polyhedron space in which windows are displayed on screen in a manner reflecting three-dimensional space—windows are located on these polyhedron faces or sides and not overlaid with objects. These planes do not correspond to the overlay plane of the present application because instead of being planes that are put in a window, they define the appearance of the windows by requiring the outer perimeter of the window to conform its shape to that of the plane. Furthermore, the control buttons cited by the Examiner are part of the windows displayed in the various planes of the Horvitz et al. disclosure as shown in FIG 3. For example, Horvitz et al. recite on col. 12, lines 12-20:

A system menu button 60, a title bar 62, a push back button 64, a perspective-transform left button 66, and a perspective-transform right button 68 are shown along the top of window 40. The same control buttons are displayed in the same position on the window 46 appearing on the back plane 44 and in a left-to-right arrangement as illustrated on the window 40.

Horvitz et al. further disclose on col. 12, line 27, to col. 13, line 50, and col. 11, line 66, to col. 12, line 10, that selecting a control button on one of the windows results in a movement of windows between the faces or sides of the polyhedron space and not in any overlaying operation as described in the present application.

Horvitz et al. do describe on col. 8, line 66, to col. 9, line 9, the control buttons as “child windows” specifically stating:

The window 30 may contain additional, smaller windows called “child windows”, which are subspecies or subclasses of windows. Child windows may take the form of push buttons, radio buttons, check boxes, text entry fields, list boxes, and scroll bars, and the like. These objects when displayed on the computer screen may be pressed or clicked or scrolled. *A user sees a window as an object on a screen, and interacts directly with the object by pushing buttons 34, or scrolling a scroll bar, or tapping a handle displayed in the window 30.* Buttons 34 may control a function for a particular window.

(Emphasis added). Horvitz et al. are describing the window as the object on the screen—not the “child window”, which is an object in the window—and Horvitz et al. point out that a user interacts with the window by initiating a

user action on one of these objects (the so-called “child windows”) in the window. These “child-windows” are not the same as the overlay plane of the claimed invention because the buttons they contain are not displayed in response to a request initiated by a behavior of a user viewing the larger window in which they appear. The child windows are not displayed in response to such a request because they, and the windows in which they are located, appear on screen at the same time. The requirement in the claims that the object be displayed in response to this request implies that the window is displayed first, then the request based on viewing the window is initiated, and then, finally, the object is displayed.

Applicants respectfully submit that the Horvitz et al. disclosed plane (i.e., a side of the polyhedron space) and use of control buttons is not the same as the overlay plane of the present application.

Examiner further contends in the Office Action on page 3 that Lui et al. “disclose the limitation of creating overlay and overlaying the created overlay plane with the window as the technique of creating Adjuct [sic] *Window* 850 and overlaying the Adjunct *window* on the top of another window 810 of window screen (see Fig. 5)” (emphasis added). Applicants respectfully submit Lui et al. as with Park et al. disclose using a separate window to display additional content unlike the present application which overlays content in the window of an application without using a separate window. The Adjunct window disclosed by Lui et al. is not the same as the overlay plane of the present application.

As stated above, independent claims 1, 17, 20, 23, 31, 47, 77, and 83-85 all recite “in a window of a software application”. These independent claims identify the overlaying of the object occurring within the window—not using a separate window such as the adjunct window recited by the Examiner in making his rejection.

Also as stated above, Applicants disclose in the Specification at page 3, lines 13-18:

Conventional means have not overcome the limitations of this restricted display and the only way to present a greater amount of information is to provide scrolling within an application window (the window may be the screen display) or by displaying a new window of information. The present

invention solves this need by providing an alternative method of reusing the display space ***without calling new windows*** or leaving the data already being displayed on the screen.
(Emphasis added)

As previously discussed, Applicants disclose that the present invention allows the overlaying of content with the window either directly (e.g., through direct compositing as discussed in the Specification on page 6, lines 15-29) or by using an intrinsic layering feature of the window-based application software—not by using additional windows such as the adjunct window of Lui et al. *See* Specification, page 4, lines 2-13.

Unlike the present application, Lui et al. disclose in col. 9, lines 51-65:

FIG. 5 illustrates the use of ***an Adjunct Window 850 that coexists and is displayed with the Host Application***. Besides the Host App's GuiObjs e.g. menu items 825, shown also with Animated Highlighting 805 and the Guide Character 815, the Adjunct Window 850 is a general purpose view area for providing different functionality from Activities which are interactive applications, to network activities such as online chat. The CHA Activity invoked in the CHA Activity Mode is a complex and robust multimedia expression and information presentation that is intended to complement, illustrate, or clarify underlying concepts behind the operations being demonstrated on the Host Application. ***Running on its own process, the Adjunct i.e. Activity Window 850 provides an independent method for handling any type of data display*** in any format such as graphics, video, and text.

(Emphasis added). Lui et al. further recite the separate nature of the Adjunct Window in col. 10, lines 6-10, stating: “Events occurring in both the Host Application as well as in the Adjunct Window 850 are not necessarily independent, or the Host Application and the Adjunct Window 850 can be closely synchronized through the CHA System's internal messaging.” Lui et al. at col. 11, lines 14-23, further recite that the graphical effects of their CHA help/tutorial system are not part of the host application let alone the window of the host application concerned:

Using the Expression Engine, superimposed graphical effects can also be used to emphasize elements of the interface. For example, GuiObjs displayed on a screen which are not part of a CHA Sequence can be “diffused”, that is, a mask bitmap is laid

over the entire interface with regions in the mask as windows or “holes” for enable GuiObjs to be displayed therein. The mask bitmap is “grayed” out i.e. defocused or colored differently to simplify the correct interface for the user, *and overlaid the interface of the live Host Application.*

(Emphasis added). Lui et al. recite that the implementation of graphical effects is conducted through an overlay (mask bitmap) overlaid with the host application as part of the CHA application and is not implemented within a window of the host application as stated in the present application. In addition to the Adjunct Window, Lui et al. on col. 11, lines 24-36, recite that activity windows are also, as their name implies, separate windows that are not part of or integrated with a window of the host application:

FIG. 6 shows the basic Activity window 620 in relation to the Host Application 605 and its GuiObjs e.g. 610, containing CHA Controls 625 along with the character 630 who coordinates events between the Host App and the Activity Window. CHA Controls 625 contain interfaces for main control of the Activity Window and its general operation and processing such as termination of the Activity, closing of the Activity, and so on. The purpose of the CHA Activity Window is to present a user with an interactive program i.e. Activity which illustrates a concept or aspect about the Host Application or provides training. *Although appearing in a separate window and possibly internally in its own operating system process*, this Activity program is still linked for bi-directional communication with the Host Application.

(Emphasis added). Applicants respectfully submit that the Lui et al. disclosed overlay and overlaying as shown in the technique of creating and overlaying the Adjunct Window is not the same as the overlay plane of the present application.

Claims 2-3, 5-8, 10-15, 26-27, and 29-30 ultimately depend on claim 1 and therefore ultimately include all of the limitations of claim 1. Claims 32-33, 35-38, 40-45, 56-61, 70-72 and 74 ultimately depend on claim 31 and therefore ultimately include all of the limitations of claim 31. Claims 78-82 ultimately depend on claim 77 and therefore ultimately include all of the limitations of claim 77. Claims 87-90 and 92 ultimately depend on claim 85 and therefore ultimately include all of the limitations of claim 85. Claims 17, 20, 23, and 47 have been amended and rewritten into independent form.

Claim 19 depends on claim 17 and therefore includes all of the limitations of claim 17. Claims 21-22 depend on claim 20 and therefore include all of the limitations of claim 20. Claim 25 depends on claim 23 and therefore include all of the limitations of claim 23. Claims 48-51 ultimately depend on claim 47 and therefore ultimately include all of the limitations of claim 47. Claims 18 and 24 have been cancelled.

Applicants respectfully request the withdrawal of this objection for at least the aforementioned reasons.

IV. Rejection of Claims 4, 16, 34, and 46 under 35 U.S.C. § 103(a)

Claims 4, 16, 34, and 46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Park et al., Horvitz et al., Lui et al., and U.S. Patent No. 6,643,652 to Helgeson et al. (“Helgeson et al.”). Applicants respectfully submit that this rejection should be withdrawn for at least the following reasons.

In order to establish obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). The arguments made above make plain that the combination of Park et al., Horvitz et al., and Lui et al. do not disclose, or even suggest, all of the limitations of claim 1, from which claims 4 and 16 ultimately depend, and claim 31, from which claims 34 and 46 ultimately depend. Helgeson et al. are not relied upon for disclosing or suggesting the limitations of claims 1 and 31 not disclosed by the combination of Park et al., Horvitz et al., and Lui et al. It is therefore respectfully submitted that the combination of Park et al., Horvitz et al., Lui et al., and Helgeson et al. does not render unpatentable claims 4 and 16, which ultimately depend on claim 1, and claims 34 and 46, that ultimately depend on claim 31.

V. Rejection of Claims 9, 39, and 91 under 35 U.S.C. § 103(a)

Claims 9, 39, and 91 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Park et al., Horvitz et al., Lui et al., and U.S. Patent No. 6,452,609 to Katinsky et al. (“Katinsky et al.”). Applicants respectfully submit that this rejection should be withdrawn for at least the following reasons.

Claim 9 depends from claim 1 and therefore includes all of the limitations of claim 1. Claim 39 depends from claim 31 and therefore includes all of the limitations of claim 31. Claim 91 depends from claim 85 and therefore includes all of the limitations of claim 85. As more fully set forth above, it is respectfully submitted that the combination of Park et al., Horvitz et al., and Lui et al. does not disclose, or even suggest, all of the limitations of claims 1, 31, and 85 from which claims 9, 39, and 91 respectively depend. Katinsky et al. is not relied upon for disclosing or suggesting the limitations of claims 1, 31, and 85 not disclosed or suggested by the combination of Park et al., Horvitz et al., and Lui et al. It is therefore respectfully submitted that the combination of Park et al., Horvitz et al., Lui et al., and Katinsky et al. does not render unpatentable claims 9, 39, and 91, that respectively depend on claims 1, 31, and 85.

VI. Rejection of Claims 28 and 73 under 35 U.S.C. § 103(a)

Claims 28 and 73 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Park et al., Horvitz et al., Lui et al., and U.S. Patent No. 6,288,801 to Leberl et al. (“Leberl et al.”). Applicants respectfully submit that this rejection should be withdrawn for at least the following reasons.

Claim 28 depends from claim 1 and therefore includes all of the limitations of claim 1. Claim 73 depends from claim 31 and therefore includes all of the limitations of claim 31. As more fully set forth above, it is respectfully submitted that the combination of Park et al., Horvitz et al., and Lui et al. does not disclose, or even suggest, all of the limitations of claims 1 and 31, from which claims 28 and 73 respectively depend. Leberl et al. is not relied upon for disclosing or suggesting the limitations of claims 1 and 31 not disclosed or suggested by the combination of Park et al., Horvitz et al., and Lui et al. It is therefore respectfully submitted that the combination of Park et al., Horvitz et al., Lui et al., and Leberl et al. does not render unpatentable claims 28 and 73, that respectively depend on claims 1 and 31.

VII. Objection to Claims 52-55 and 62-69

Claims 52, 62, and 66 were objected to as being dependent upon a rejected base claim but would be otherwise allowable if rewritten in independent form. Claims 53-55 were objected to as being dependent on claim 52. Claims 63-65 were objected to as being dependent on claim 62. Claims 67-69 were objected to as being dependent on claim 66. Applicants respectfully submit that these objections should be withdrawn for at least the following reasons.

Applicants gratefully acknowledge Examiner's careful consideration of the allowable nature of these claims. Applicants have rewritten claims 52, 62, and 66 in independent form with all the limitations of the base claims. Claims 53-55 are dependent on amended claim 52. Claims 63-65 are dependent on amended claim 62. Claims 67-69 are dependent on amended claim 66. Applicants have complied with Examiner's criteria for allowance. For at least these reasons, Applicants respectfully request the withdrawal of these objections and the allowance of these claims.

CONCLUSION

Applicants respectfully submit that all pending claims of the present application are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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